REMARKS

This amendment is responsive to the Office Communication dated February 24, 2000. The patent sought to be reissued is believed to be in a condition for allowance. Applicant respectfully requests notice to that effect.

In paragraph 2, the Office Action requests information regarding litigation. There is no pending litigation.

Paragraphs 3 and 4 presume the existence of an assignee and requires consent of all assignees. There are no assignees. The patent is held by the inventor who has given non-exclusive licenses to Industrial Environmental Concepts, Inc. and Lemna Corporation. Accordingly, it is believed that the objection under 37 CFR 1.172(a) should be withdrawn. Applicant requests notice to that effect.

The specification was objected to as not being in proper form in accordance with MPEP 1411. A declaration in the form requested by the Examiner is submitted herewith. Accordingly, it is believed that the objection has been overcome and should be withdrawn. Applicant requests notice to that effect.

Paragraphs 6 and 7 of the Office Action set forth an objection to the drawings. Specifically, it is noted that the previously proposed drawing changes would be accepted if the word "AMENDED" was added to the changed sheets. Supplemental proposed drawings are submitted herewith. Accordingly, applicant believes the present objection has been overcome and should be withdrawn. Applicant requests notice to that effect.

Claims 4-12, 14-16 and 18-48 were rejected under 35 U.S.C. 251 as being an improper capture of claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Specifically, the present claims are stated to violate the recapture rule. Applicant respectfully traverses.

The Office action states that the broadened subject matter was surrendered in the prior application, citing to *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984); *Hester Indus. Inc. v. Stein, Inc.*, 142 F. 3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); and *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997). Such cases set forth the appropriate analysis.

> In considering the "error" requirement, we keep in mind that the reissue statute is based on fundamental principles of equity and fairness and should be construed liberally....One of the commonly asserted "errors" in support of a broadening reissue is the failure of the patentee's attorney to appreciate the full scope of the invention during the prosecution of the original application. This form of error has generally been accepted as sufficient to satisfy the "error" requirement of §251.

Hester 131 F.3d at 1479-80.

"Under the recapture rule, claims that are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible." Id. at 1480. "The first step in applying the recapture rule is to determine whether and in what 'aspect' the reissue claims are broader than the patent claims." *Clement* 131 F.3d at 1468. In the present case, the aspects are set forth to a degree and applicant agrees that the claims are broader than the original claim. Clarity

on which aspects are in fact broadening is of no import in the present case for the reasons set forth below.

"The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection." *Id.* at 1468-69 (citing *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984). In all three cases cited in the present office action, the act of surrendering was "an overt act on the part of the applicant" in arguing that particular claim limitations in the claims distinguished over the prior art and those limitations were the ones the applicant tried to remove on reissue. *Clement,* 131 F.3d at 1470; *Ball*, 729 F.2d at 1437; and *Hester*, 142 F.3d at 1482. The relevant issue is the "intent" of the applicant. *Clement,* 131 F.3d at 1469.

In the present case, we have no cancellation of claims, argument or other file history to show surrender. The Office Action doesn't point to claim changes, argument or the like made by or on the behalf of the applicant. There has been no surrender and the recapture rule has not been violated.. "The recapture rule does not apply in the absence of evidence that the applicant's amendment was 'an admission that the scope of the claim was not in fact patentable.'" *Clement*, 131 F.3d 1469.

However, the Office Action continues and points to the comments of the prior Examiner and asserts that the applicant surrendered by way of silence. While silence can operate in certain circumstance as an admission, at minimum is required a course

of such dealing or a motivation to not be silent. This is not such a circumstance where silence applies as an admission, there is no course of dealing and there is no motivation for the applicant to have responded to the Examiner's statement. Accordingly, applicant believes the rejection under 35 U.S.C. 251 should be withdrawn.

The Oath/Declaration was objected to under 37 CFR 1.175(b)(1). Enclosed pleased find a substitute Oath/Declaration. Accordingly, it is believed that the present objection has been overcome and should be withdrawn. Notice to that effect is respectfully requested.

Applicant submits that all objections and rejections have been overcome and should be withdrawn and that the patent sought to be re-issued is in a condition for

allowance. Notice to that effect is respectfully requested. Any questions concerning this application may be directed to **N. Paul Friederichs at (612) 862-0517.**

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